The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT CAHN

MAILED
JUN 19 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2006-0938
Application No. 09/643,473

ON BRIEF

Before THOMAS, SAADAT and MacDONALD, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-8, which are all of the claims pending in this application.

We reverse and enter a new rejection pursuant to 37 CFR § 41.50(b).

BACKGROUND

Appellant's invention relates to a method for monitoring the status of a network based on information describing current network topology and possible restoration routes. A network management system computes three measures of network health, each relating to a different aspect of network health to obtain a measure of overall network performance. By comparing the measures of network health to a threshold value, an optimum

restoration route from the stored routes may be selected.

Representative independent claim 1 is reproduced below:

1. A method for monitoring the status of a network comprising:

computing a plurality of measures of network health, including a sum of unrouted traffic, a sum of traffic whose cost exceeds a prescribed multiple of an optimal route cost, and a sum of traffic off an optimal path; and

comparing said measures of network health to a threshold value and selecting a restoration route from a plurality of stored restoration routes.

The Examiner relies on the following references in rejecting the claims:

| | | |
|---|---|---|
| Callon | 6,256,295 | Jul. 3, 2001 (filed Sep. 25, 1997) |
| Bentall et al. (Bentall) | 6,282,170 | Aug. 28, 2001 (filed May 29, 1997) |
| Srinivasan et al.(Srinivasan) | 6,304,549 | Oct. 16, 2001 (filed May 8, 1997) |

Claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Callon and the Official Notice taken by the Examiner.

Claims 2 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Callon and Bentall.

Claims 3, 4, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Callon and Bentall and further in view of Srinivasan.

Rather than reiterate the opposing arguments, reference is made to the brief and answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments

which Appellant could have made but chose not to make in the brief have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

35 U.S.C. § 103 Rejection

In rejecting claims 1 and 5, the Examiner relies on Callon for teaching the claimed features except for the step of measuring a sum of each of the computed measures (answer, page 4). The Examiner further takes Official Notice that it would have been obvious to calculate a sum of each category by simply adding each indication (id.).

Appellant argues that the cited portions in Callon do not disclose the claimed subject matter (brief, page 5). Appellant points out that Callon provides for redundant virtual circuits by establishing multiple virtual circuits between a source node and a destination node of a network, which may be used if a failure along one of the paths occurs (id.). Appellant concludes that Callon, rather than monitoring the status of an operating network, determines backup paths for network problems without making any of the claimed measurements (id.).

The Examiner responds that the claims do not include the definition of the three types of the claimed traffic as the measures of network health (answer, page 6). The Examiner further points out that calculating a sum of each of Callon's evaluation of the non-overlapping paths (col. 2, lines 46-60) and specifically, unreachable traffic path (col. 3,lines 1-4, col. 5, line 24-25), computed cost of a path (col. 3, lines 1-4, 58-67;

col. 5, lines 11-20) and compatible cost paths (col. 3, lines 1-4; col. 5, lines 3-20) is only a simple question of how many in total are identified (answer, page 8).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).

After a review of the prior art references, we agree with Appellant's arguments. While determining the lowest cost paths (col. 3, lines 58-67) and alternate paths among non-overlapping path and using the Dijkstra algorithm to find the shortest path (col. 6, lines 53-64), Callon includes no provision for computing a plurality of measures of network health in the form of a sum of three types of traffic over failed links. Contrary to the Examiner's position (answer, pages 7-8), the claims include the specific things that need to be measured such as a sum of

unrouted traffic. These measures are used in the next claimed step for selecting a restoration route.

We also remain unconvinced by the Examiner's rationale that it would have been obvious to calculate the sum of the recited traffic on failed links. Although the manner in which a sum calculation is performed may be well known, absent a suggestion, motivation or reasoning, choosing which parameters to use for the sum calculation is not readily obvious to the skilled artisan. Since Callon includes no disclosure related to any of the recited measures and how the sums of various elements relating to traffic problems may be determined and used for selecting a restoration route, its modification, as held by the Examiner, would still not disclose the recited features of independent claims 1 and 5. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 1 and 5 over Callon and taking of Official Notice cannot be sustained.

With respect to the rejection of the remaining claims, the Examiner further relies on Bentall and Srinivasan (answer, pages 4-6). However, neither of these references overcomes the deficiencies of Callon as modified by taking the Official Notice, as discussed above with respect to claim 1. Therefore, the 35 U.S.C. § 103 rejection of claims 2 and 6 over Callon and Bentall and of claims 3, 4, 7 and 8 over Callon and Srinivasan cannot be sustained.

New ground of rejection

We make the following new ground of rejection for claims 1-8 under the second paragraph of 35 U.S.C. § 112 as being indefinite, pursuant to 37 CFR § 41.50(b).

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The purpose of 35 U.S.C. § 112, second paragraph, "is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance." In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). As such, "[t]he legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Therefore, analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. In re Johnson, 558 F.2d 1008, 1015,

194 USPQ 187, 193 (CCPA 1977), citing In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Initially, we note that instant claims 1 and 5 include the limitation of "comparing said measures of network health to a threshold value." The term "measures," as indicated to be related to various aspect of the network traffic over failed links, represents plural elements. Appellant appears to claim comparing a plurality of measures to one single threshold value. Since, the instant specification contains no details or examples related to the nature of the "threshold value," we cannot determine with certainty whether all the measures are compared to the same threshold value or each measure is separately compared to a different value.

We enter this new ground of rejection so that, instead of speculating the meaning of the claims, ambiguities are recognized and corrected before the conclusion of prosecution of the application before the Office, when claims can be amended. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-8 under 35 U.S.C. § 103 is reversed.

A new rejection of claims 1-8 under the second paragraph of 35 U.S.C. § 112 as being indefinite is entered.

In addition to reversing the Examiner's decision with respect to the 35 U.S.C. § 103, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv).

REVERSED
37 CFR § 41.50(b)

JAMES D. THOMAS
Administrative Patent Judge )

MAHSHID D. SAADAT
Administrative Patent Judge ) BOARD OF PATENT APPEALS AND INTERFERENCES

ALLEN R. MACDONALD
Administrative Patent Judge )

MDS/gw

MR S H DWORETSKY
AT&T CORP
P.O. BOX 4110
MIDDLETOWN, NJ 07748